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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,100

11/17/2003

Dharma R. Kodali

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EXAMINER

KRUSE, DAVID H

ART UNIT

PAPER NUMBER

1638

NOTIFICATION DATE

DELIVERY MODE

09/09/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/715,100	<b>Applicant(s)</b> KODALI ET AL.	
	<b>Examiner</b> David H. Kruse	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24 and 26-46 is/are pending in the application.
- 4a) Of the above claim(s) 42-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24, 26-41, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/17/2003</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **STATUS OF THE APPLICATION**

1. This Office action is in response to the Amendment and Remarks filed 14 December 2007.
2. Those objections or rejections not specifically addressed in this Office action are withdrawn in view of Applicants' amendments to the claims.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

4. Claims 42-44 remain withdrawn from further consideration pursuant to 37 CFR § 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 16 May 2007.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the fourth paragraph of 35 U.S.C. § 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

7. Claim 46 is rejected under 35 U.S.C. § 112, fourth paragraph, as failing to further limit the subject matter of a previous claim upon which it depends. The limitation “about 82%” is broader than the limitation “at least 82%” at claim 24.

***Claim Rejections - 35 USC § 103***

8. Claims 24 and 26-41 remain rejected and claims 45 and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong (5,638,637-US, 24 November 1998) in view McVetty ((1996) Can. J. Plant Sci. 76:343-344.) and further in view of Downey ((1963) Can. J. Plant Sci. 43:271-275), and in light of Siebel ((1989) TAG 77:489-494). This rejection is repeated for the reason of record as set forth in the last Office action mailed 6 August 2007. Applicant's arguments filed 14 December 2007 have been fully considered but they are not persuasive.

Applicants argue that Wong indicates that erucic acid has deleterious effects on human health and indicates it would be useful to increase the oleic acid content of canola (which refers to oil containing 2% erucic acid). Applicants argue that Wong does not direct a person of ordinary skill to a method of making a *Brassica* plant producing seeds in which a high erucic acid line is crossed with a high oleic acid line and progeny are selected that produce seeds having a long chain monounsaturated content of at least 82%, where the erucic acid content is at least 15% (page 13, 2<sup>nd</sup> paragraph of the Remarks). This argument is not found to be persuasive. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant

Art Unit: 1638

case, Wong teaches *Brassica napus* plants that are capable of transmitting high oleic acid content to progeny, said high oleic acid content being above 85% (see for example claim 1). Wong teaches that this high oleic acid trait can be readily transferred to other *Brassica* sp. using standard plant breeding techniques already well documented in the technical literature (column 7, lines 23-27), hence one of ordinary skill in the instant art would have had a reasonable expectation of success in crossing such a high oleic acid producing plant with a high erucic plant and selecting progeny with high oleic acid content.

Applicants argue that Downey indicates that erucic acid content is not controlled in a dominant fashion. Siebel indicates that erucic acid content in *Brassica napus* is simply inherited and controlled by two genes acting in an additive manner. Applicants argue that Siebel indicates that high erucic acid oils are useful as lubricants. Applicants argue that Siebel also indicates that strong negative correlations between erucic acid and C18 fatty acids were observed, i.e., as erucic acid levels increase, oleic acid and linoleic acid levels decrease, or alternatively, as oleic acid and linoleic acid levels increase, erucic acid levels decrease (page 13, 3<sup>rd</sup> paragraph of the Remarks). These arguments are not found to be persuasive. Given the teachings of Downey, it would be readily apparent to one of ordinary skill in the instant art that crossing a high erucic acid *Brassica* with a low erucic acid *Brassica* would result in an approximate halving of the erucic acid content in the progeny (see Table 1 on page 272); hence crossing a *Brassica* with at least 45% erucic acid content with a *Brassica* with at least 82% oleic acid (such as those taught by Wong having undetectable erucic acid) would result in a

Art Unit: 1638

progeny having half the amount of erucic acid, i.e. at least 15% erucic acid. Downey teaches that the *Brassica* variety 'Golden' has on average 41.3% C<sub>22</sub> fatty acids which one of ordinary skill in the art would recognize as being comprised predominantly of erucic acid. As a population of *Brassica* variety 'Golden' would vary around such an average in the content of erucic acid, one of ordinary skill in the instant art would recognize that individuals within said population would meet the limitation of the instant claim(s) as having an erucic acid content of at least 45%.

Applicants argue that as indicated in the specification, the long chain monounsaturated fatty acid content is distributed primarily among oleic acid (C 18:1), eicosenoic acid (C20:1), and erucic acid (C22:1). Applicants argue that the heterogeneous nature of the long chain monounsaturated fatty acids in the seed oil triacylglycerols confers desirable properties to the oil, including desirable low temperature properties, oxidative stability, and high fluidity characteristics. Applicants argue that in contrast, the cited references indicate that either high erucic acid oils are useful or high oleic acid oils are useful (paragraph spanning pages 13-14 of the Remarks). These arguments are not found to be persuasive. The usefulness of the oils, in the instant case is irrelevant. The instant claims are directed to a method of making a *Brassica* plant. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention).

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The central FAX number for official correspondence is 571-273-8300.

Art Unit: 1638

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-1600.

/David H Kruse/  
Primary Examiner, Art Unit 1638  
3 September 2008